REMARKS

Favorable reconsideration of this application, in light of the preceding claim amendments and following remarks, is respectfully requested.

Claims 1-11, 13-17 and 19 are pending in this application. Claims 1 and 12 are amended. Claims 11 and 18 are cancelled. Claim 19 is newly added. Claims 1, 12 and 19 are independent.

Drawings

Applicants acknowledge with appreciation the Examiner's indication in the Advisory Action mailed July 5, 2006 that the drawings filed April 25, 2002 have been accepted by the United States Patent and Trademark Office (USPTO).

Claim Rejections Under 35 U.S.C. § 103

Claims 1-3 and 10

Claims 1-3 and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lager et al. (U.S. Patent No. 6,636,502, herein Lager) in view of Tiedemann, Jr., et al. (U.S. Patent No. 6,216,004, herein Tiedemann). Applicants respectfully note that the features of claim 11 have been incorporated into amended independent claim 1, thereby rendering the rejection of claims 1-3 and 10 in view of Lager and Tiedemann moot.

Amended Claim 1 and Claims 4, 6, 9 and 11

Claims 4, 6, 9 and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lager and Tiedemann in view of Dunn et al. (U.S. Patent No. 6,591,103, herein Dunn). Because amended independent claim 1 includes the features of claim 11, the following comments are

provided that patentably distinguish amended independent claim 1 over the references of <u>Lager</u>,

<u>Tiedemann</u> and <u>Dunn</u>.

Initially, Applicants maintain the arguments set forth in the previous Request for

Reconsideration filed June 7, 2006. However, in the interest of furthering prosecution, claim 1

has been amended to recite, *inter alia*, "receiving, at an access network, an access request and a

token from an access terminal, ..., *wherein the token includes a plurality of bits, each bit*

associated with a different parameter group type." Applicants respectfully submit that at least

the emphasized feature of amended independent claim 1 patentably disguishes claim 1 over

<u>Lager</u>, <u>Tiedemann</u> and <u>Dunn</u>.

<u>Lager</u> is directed to a switching device (PLMN-SW) in a mobile radio communication

system (PLMN), which allows a terminal station (GPRS-MS) to connect with one of a plurality

of packet data communication networks (PDN1, PDN2, IN).[1] In <u>Lager</u>, a "network request

means NRM of said terminal station GPRS-MF is provided for sending said selected network

indication parameter NIP to said switching device PLMN-SW *in order to request a connection*

to the packet data communication system indicated by said network indication parameter

NIP."[2] The network indication parameter NIP does not provide any indication as to whether the

terminal station GPRS-MS is operating according to a default parameter group, but instead

merely instructs the switching device PLMN-SW with which packet data network to connect.

In response to this argument, which was previously set forth in the Amendment filed

November 10, 2005, the Office Action mailed March 2, 2006 states the following:

> The NIP is used to determine whether the terminal station operates according to
> the subscription parameters of the switch. Therefore, the request indicates

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[1] <u>Lager</u>, FIG. 8.
[2] <u>Lager</u>, column 12, lines 43-49.

whether the terminal station GPRS-MS operates according to a default parameter group.[3]

However, Applicants respectfully note that the subscription parameters merely indicate if the GPRS-MS is registered for a particular Internet Service Provider (ISP), for example COMPUSERVE, T-ONLINE, etc, as described in Lager.[4] Accordingly, Applicants respectfully submit that the request including the NIP does not indicate if the terminal station GPRS-MS operates according to a default parameter group. Instead, the NIP merely instructs the switching device PLMN-SW which packet data network to connect to, and the switching device PLMN-SW determines if the terminal station GPRS-MS subscribes to the particular ISP indicated by the NIP before connecting the terminal station GPRS-MS to the ISP.

Further, the Examiner has acknowledged on multiple occasions that Lager does not disclose the token as recited in claim 1.[5] The Examiner relies on Tiedemann to teach "using a bit to indicate access parameters in a wireless communication network (Col. 5, lines 1-5)."[6]

However, Tiedemann merely states that an "extended system parameters message" may have a 1-bit flag that indicates whether an Access Probe Handoff is permitted to a base station.[7]

Accordingly, Applicants respectfully submit that even if Lager and Tiedemann are combinable, which the Applicants do not admit, the combination fails to disclose, teach or suggest the method of independent claim 1 including "receiving, at an access network, an access request and a token from an access terminal, ..., *wherein the token includes a plurality of bits, each bit associated with a different parameter group type*."

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[3] Office Action mailed March 2, 2006, page 17, lines 3-7.
[4] Lager, column 16, line 67 to column 17, line 2.
[5] Office Action mailed March 2, 2006, page 3, lines 17-21; Advisory Action mailed July 5, 2006, Application Sheet (PTOL-303), lines 22-24.
[6] Office Action mailed March 2, 2006, page 3, lines 22-23.
[7] Tiedemann, column 2, lines 1-6.

With respect to claim 11, which previously included the above-emphasized feature of amended independent claim 1, the Office Action mailed March 2, 2006 cites column 11, lines 27-30 of Dunn as teaching a token that includes a plurality of bits, each bit associated with a different parameter group type.

However, this portion of Dunn is claim language that merely states "the assigned network being electable by the user thereby providing the user with a preferred protocol, bandwidth, and cost."

Accordingly, Dunn also fails to disclose, teach or suggest "receiving, at an access network, an access request and a token from an access terminal, …, *wherein the token includes a plurality of bits, each bit associated with a different parameter group type*," as recited in amended independent claim 1.

Therefore, Applicants respectfully submit that claim 1 is allowable over Lager, Tiedemann and Dunn based at least on the deficiencies of the references with respect to the above-emphasized feature.

With respect to the combination of Lager, Tiedemann and Dunn, Applicants respectfully submit that the Examiner has not provided the required convincing line of reasoning for combining the teachings of these references. Namely, the Examiner has failed to identify any specific portion in any of the cited references that would motivate one skilled in the art to modify the method of selecting a packet data network as described in Lager, which is based on the network indication parameter, to include a flag bit of Tiedemann regarding handoff. Further, Applicants respectfully that the cited portion of Dunn does not even identify a teaching of Dunn to be included with Lager and Tiedemann, much less provide motivation for modifying Lager and Tiedemann based on the teachings of Dunn. In place of the required motivation, the

Examiner merely makes the conclusory statement that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Lager, Tiedemann, and Dunn because the teachings of Dunn to provide a plurality of parameters would enhance the system of Lager and Tiedemann by allowing to user to indicate a greater preference of connection requirements as well as the connection capabilities of the user."[8] Applicants respectfully note that the MPEP specifically states that "[t]he mere fact that the reference <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

In light of the above, Applicants respectfully submit that amended independent claim 1 is allowable over the cited references of <u>Lager</u>, <u>Tiedemann</u> and <u>Dunn</u> and respectfully request that the rejection under 35 U.S.C. § 103(a) of claims 4, 6 and 9, that depend from amended independent claim 1, be withdrawn.

Claim 5

Claim 5 stands rejected under 35 U.S.C. §103(a) as unpatentable over <u>Lager</u>, <u>Tiedemann</u>, <u>Dunn</u> and further in view of <u>Raith</u> (U.S. Patent No. 5,241,598). Applicants respectfully traverse this rejection for the reasons detailed below.

Applicants respectfully submit that <u>Raith</u> also fails to cure the deficiencies of <u>Lager</u>, <u>Tiedemann</u>, and <u>Dunn</u> as described above with respect to amended independent claim 1, and thus, dependent claim 5 is allowable over the cited references for at least the same reasons as discussed above with respect to amended claim 1.

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[8] Office Action mailed March 2, 2006, page 7, lines 11-15.

Therefore, Applicants respectfully request that the rejection of claim 5 under 35 U.S.C. § 103(a) be withdrawn.

Claims 7 and 8

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over <u>Lager</u>, <u>Tiedemann</u>, and <u>Dunn</u> in view of <u>La Porta et al.</u> (U.S. Patent No. 6,085,086, herein <u>La Porta</u>). Applicants respectfully traverse this rejection for the reasons detailed below.

Applicants respectfully submit that <u>La Porta</u> also fails to cure the deficiencies of <u>Lager</u>, <u>Tiedemann</u>, and <u>Dunn</u> as described above with respect to amended independent claim 1.

Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) of claims 7 and 8, which depend from independent claim 1, also be withdrawn.

Claims 12, 14, 17 and 18

Claims 12, 14, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over <u>Dunn</u> in view of <u>Tiedemann</u>. Applicants respectfully traverse these rejections for the reasons detailed below.

Amended independent claim 12 also includes features somewhat similar to those discussed above with regard to amended independent claim 1. As explained above, both <u>Dunn</u> and <u>Tiedemann</u> fail to disclose, teach or suggest a method, wherein "***the token includes a plurality of bits, each bit associated with a different parameter group type***," which is recited in amended independent claim 12.

Thus, for at least reasons somewhat similar to those set forth above with regard to claim 1, Applicants respectfully submit that both <u>Dunn</u> and <u>Tiedemann</u> fail to disclose, teach or suggest all of the features of claim 12.

Therefore, Applicants respectfully request that the rejection of claims 12, 14, 17 and 18 under 35 U.S.C. § 103(a) be withdrawn.

Claim 13

Claim 13 stands rejected under 35 U.S.C. § 103(a) as unpatentable over <u>Dunn</u> and <u>Tiedemann</u> in view of <u>Raith</u>. The Applicants respectfully traverse this rejection as detailed below.

Applicants respectfully submit that <u>Raith</u> also fails to cure the deficiencies of <u>Dunn</u> and <u>Tiedemann</u> as described above with respect to independent claims 1 and 12. Thus, dependent claim 13 is allowable over the cited references for at least the same reasons as discussed above with respect to independent claim 12.

Therefore, Applicants respectfully request that the rejection of claim 13 under 35 U.S.C. § 103(a) be withdrawn.

Claims 15 and 16

Claims 15 and 16 stand rejected under35 U.S.C. § 103(a) as unpatentable over <u>Dunn</u> and <u>Tiedemann</u> in view of <u>La Porta</u>. The Applicants respectfully traverses these rejections for the reasons detailed below.

Applicants respectfully submit that <u>La Porta</u> also fails to cure the deficiencies of <u>Dunn</u> and <u>Tiedemann</u> as described above with respect to independent claims 1 and 12. Thus,

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dependent claims 15 and 16 are allowable over the cited references for at least the same reasons

as discussed above with respect to independent claim 12.

Therefore, Applicants respectfully request that the rejection of claims 15 and 16 under 35

U.S.C. § 103(a) be withdrawn.

New Claim 19

Applicants respectfully submit that none of the cited references disclose, teach or suggest

a method for configuration negotiation in a data communication system including "storing

parameter groups of parameter group types previously established between an access network

and an access terminal." Accordingly, Applicants respectfully submit that claim 19 is in

condition for formal allowance.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the

objections and rejections and allowance of each of claims 1-18 in connection with the present

application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present

application; the Examiner is respectfully requested to contact Scott A. Elchert at the telephone

number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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